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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,254	01/20/2004	Silke Kohlhase	P24854	6922

7055	7590	07/20/2007
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EXAMINER	
WEDDINGTON, KEVIN E	

ART UNIT	PAPER NUMBER
1614	

NOTIFICATION DATE	DELIVERY MODE
07/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/759,254	Applicant(s) KOHLHASE ET AL.	
	Examiner Kevin E. Weddington	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-81 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21-27, 35-38, 40, 42, 44, 45, 46, 47, 49, 51, 53, 55, 57, 59-62, 66, 67, 70, 72, 74, 76, 78 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9-14-04; 12-2-05</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 20,28-34,39,41,43,48,50,52, 54, 56,58,63-65,68,69,71,73,75,77,79 and 81.

Claims 19-81 are presented for examination.

Applicants' preliminary amendment filed July 7, 2004; and the information disclosure statements filed September 14, 2004 and December 2, 2006 have been received and entered.

Applicants' election filed June 29, 2007 in response to the restriction requirement filed June 8, 2007 has been received and entered. The applicants elected the invention described in claims 19, 21-27, 35-38, 40, 42, 44, 45, 46, 47, 49, 51, 53, 55, 57, 59-62, 66, 67, 70, 72, 74, 76, 78 and 80 (Group I) with traverse.

Applicants' traverse is not deemed persuasive for reasons set forth in the Office action dated June 8, 2007; therefore, the restriction requirement is hereby made Final.

Claims 20, 28-34, 39, 41, 43, 48, 50, 52, 54, 56, 58, 63-65, 68, 69, 71, 73, 75, 77, 79 and 81 are withdrawn from consideration as being drawn to the non-elected invention (37 CFR 1.142(b)).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19, 21-27, 35-38, 40, 42, 44, 45, 46, 47, 49, 51, 53, 55, 57, 59-62, 66, 67, 70, 72, 74, 76, 78 and 80 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-77 of copending Application No. 10/759,160. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the present claims and the copending claims lies in that in the present claims, an additional agent is administered with the presently claimed active agents.

The present claims would anticipate the present claims because the copending claims recite, "comprises" and thus open the claims to the inclusion of additional active agents.

Claims 19, 21-27, 35-38, 40, 42, 44, 45, 46, 47, 49, 51, 53, 55, 57, 59-62, 66, 67, 70, 72, 74, 76, 78 and 80 are not allowed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 01/20/2003. It is noted, however, that applicant has not filed a certified copy of the said application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order

for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19, 21-27, 35-38, 40, 42, 44, 45, 46, 47, 49, 51, 53, 55, 57, 59-62, 66, 67, 70, 72, 74, 76, 78 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel et al. (6,558,680 B1) in view of Chapin et al. (4,370,319).

Riedel et al. teach cosmetic and dermatological preparations (compositions) containing fatty acids, ethoxylated fatty acid esters, and fatty alcohols (see the abstract). Note particular to column 11, lines 14-24 states the cosmetic and dermatological preparations (compositions) can comprise cosmetic active ingredients such as dyes, pigments, surfactants and polymers. For example, in EXAMPLE 1, the instant preparation (composition) comprises 2 % by weight of fatty acids (stearic acid/palmitic acid); 2 % by weight of s polyethoxylated fatty acid ester (PEG-40); 3 % by weight of a fatty alcohol (cetylstearyl alcohol); and dyes. Note the instant preparation (composition) is adjusted to a pH of 6.5.

The instant invention differs from the cited reference in that the cited reference does not teach the addition of steep (IV) at least on of sodium hydroxide and potassium hydroxide. However, the secondary reference, Chapin et al., teaches skin conditioning compositions comprising an alkaline agent such as sodium hydroxide is used to neutralize the composition.

Clearly, one skilled in the art would have assumed the addition of sodium hydroxide is used to neutralize the instant cosmetic and dermatological composition


since the composition may be acidic and the additional of sodium hydroxide will adjust the acidity (pH) to basic in the absence of evidence to the contrary.

Claims 19, 21-27, 35-38, 40, 42, 44, 45, 46, 47, 49, 51, 53, 55, 57, 59-62, 66, 67, 70, 72, 74, 76, 78 and 80 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571) 272-0587. The examiner can normally be reached on 12:30 pm-9:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kevin E. Weddington
Primary Examiner
Art Unit 1614

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K. Weddington
July 16, 2007